

Serial No. 10/613,656
Response Dated 6/5/04
Response to Notice to File Missing Parts Dated 11/5/03

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Anthony ZALENSKI; John COONEY; Albert PAPP, III; Andre MILOTA;
and Darius MOSTOWFI

Serial No.: 10/613,656
Filed: 07/03/2003

Group Art Unit: Not yet assigned
Examiner: Not yet assigned

For: System and Method for Using Multiple Communication Protocols in Memory
Limited Processors

PETITION UNDER 37 C.F.R. § 1.47(a)

Honorable Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The above-identified application (the "Application") was filed in the U.S. Patent and Trademark Office on July 3, 2003 without a declaration as required under 37 C.F.R. § 1.63. A Notice to File Missing Parts of Nonprovisional Application was mailed November 5, 2003. Applicant is submitting a Declaration in compliance with 37 C.F.R. § 1.63 signed by Inventors Zalenski and Cooney, and a petition under 37 C.F.R. § 1.47(a) asserting that Inventors Papp, Mostowfi and Milota refused to execute a Declaration with respect to the Application.

PERTINENT FACTS

As noted above, the above referenced patent application was filed with missing parts on July 3, 2003. On several occasions, both before and after the filing of the Application, attempts were made to provide Inventors Papp, Mostowfi and Milota a copy of the application as filed and to obtain each of their signatures on the Declaration.

A. As To Inventor Mostowfi

On July 2, 2003, a copy of the application as subsequently filed was sent to inventor Mostowfi via e-mail by Elliott Light, an associate with this firm. Receipt of the application was acknowledged by Inventor Mostowfi via e-mail dated July 7, 2003 (**copy attached**). Inventor

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130.00 OP

Mostowfi indicated that he would review the application but for various reasons desired to have his "attorneys review all paperwork..." but would "contact them ASAP to set up time to review."

I, Jon L. Roberts, in my capacity as counsel for signing inventors Zalenski and Cooney, followed up with Inventor Mostowfi via e-mail dated July 27, 2003 (**copy attached**) to determine the status of his review of the Application. Inventor Mostowfi replied that he was represented by counsel, that his counsel was on vacation, and that I "NOT ...contact ...him directly anymore via phone, email, mail, fedex, etc. regarding this and ANY other matter." Shortly thereafter, the attorney identified as representing Inventor Mostowfi denied any such representation. In late August of 2003, Inventor Cooney was told by Inventor Mostowfi that he would never join in the application. On August 29, 2003, Mr. Cooney sent an e-mail to me (**copy attached**) stating the following:

"This morning (Friday, August 29, 2003) a little after 8:00am I received a cell phone call from Darius requesting the FAX phone number for the i2 Telecom Redwood City office. He needed this information to supply to the California EDD as part of a claim he had filed.

In the course of the phone discussion, I stated that I had been given the assignment of determining the likely hood of being able to bring the patent we had been working on to closure. I then said that it might not be possible to complete the patent work given the pending legal actions. Darius replied, no he did not think it was likely."

On March 22, 2004, I contacted the new counsel for Inventor Mostowfi by e-mail (**copy attached**) to ascertain if Inventor Mostowfi's cooperation could be obtained. His counsel refused to contact me even after another attorney who is representing my firm interceded. To this day, there has been no response from either Mr. Mostowfi or his counsel.

The last known addresses for Inventor Mostowfi is:

Darius Mostowfi
248 Beverly Drive
San Carlos, CA 94072

B. As To Inventor Milota

A copy of the Application was also sent by e-mail to Inventor Milota. While a record of a specific transmittal date could not be located, an e-mail dated July 11, 2003 to Inventor Milota (**copy attached**) made note of the transmission of the Application.

On May 6, 2004, a copy of the Application was again sent to inventor Milota via FedEx (US AirBill 841277339842, **copy attached**) along with a pre-paid return envelope. Inventor Milota again requested that he be paid for his time to read the Application. Payment was promised and Inventor Milota provided editorial comments to the written description. After numerous communications with Inventor Milota, I could not obtain his approval of the Application or agreement on changes to the Application. Inventor Milota's primary concern as communicated to me was his fear that signing the Declaration would expose him to liability to investors or purchasers. After almost a year of discussions, it is my opinion that Inventor Milota's conduct amounts to a refusal to join the Application as an inventor.

The last known addresses for Inventor Milota is:

Andre Milota
421 East 18th Street, Apt. 410
Oakland, CA 94606

C. As to Inventor Papp

Based on information and belief, a copy of the Application was provided to Inventor Papp by Inventor Cooney in late June of 2003 (just prior to the filing date). Attempts were made to obtain the signature of Inventor Papp on the declaration over period from July to October 2003.

In an e-mail dated October 3, 2003, Inventor Cooney related the content of a conversation he had had with Inventor Papp (**copy attached**). The essence of the e-mail was the Inventor Papp had refused to join in the invention with inventor Zalenski and Cooney.

I attempted to contact Mr. Papp by telephone on numerous occasions, including calls placed on May 25 and May 26 of this year. Mr. Papp did not return my calls.

It is my opinion that Inventor Papp has refused to join the Application as an inventor.

The last known address of inventor Papp is:

Albert Papp
Mountain View, California

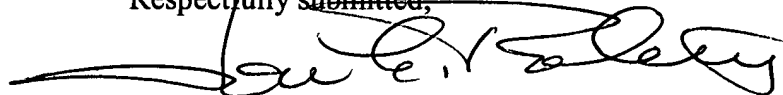
D. Conclusion

In view of the above statement of facts Applicant hereby submits: (1) a Declaration signed by Inventors Zalenski and Cooney on behalf of Inventors Zalenski, Papp, Cooney, Mostowfi and Milota, (2) the fee specified in 37 C.F.R. § 2.6, and (3) the documents referenced above in support of the statements made herein.

In view of this submission, grant of this Petition is respectfully requested.

I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jon L. Roberts", written over a horizontal line.

Jon L. Roberts
Registration No. 31,293
Roberts Abokhair & Mardula, LLC
11800 Sunrise Valley Drive
Suite 1000
Reston, VA 20191
(703) 391-2900

ATTACHMENT 1
EVIDENCE RELATING TO INVENTOR MOSTOWFI

1. E-mail dated July 7, 2003 - Receipt of the application was acknowledged by Inventor Mostowfi:

-----Original Message-----

From: Darius Mostowfi [mailto:darius@dsp.com]

Sent: Monday, July 07, 2003 2:54 AM

To: Jon Roberts

Cc: Elliott Light; Jack Robinson (E-mail 2); Tony Zalenski (E-mail)

Subject: Re: Patent Review - follow up on our phone call

Hello Jon - sorry for the delayed reply - have been out for the holiday. Hope you had a good fourth weekend.

I also received the docs from Elliot and have had a cursory review (spent about an hour on that this evening). I noticed that the addresses on the declaration for Tony and Al Papp are not correct. I believe it will take another 4 hours to complete the review - the document has changed and expanded somewhat - there are now over 40 claims as opposed to 13 on the last application. I will use some of this time (one or two hours) to review issues with John Cooney, Al and Andre - I would recommend that so we don't go back and forth on edits.

Yes, I still would like to have payment for the hours in advance - total of \$625 dollars. As I mentioned on our phone conversation several weeks ago, this is my policy for all jobs. In addition, as I mentioned then also, during the takeover and merger there were threats to sue me issued by i2 management regarding IP work and employment matters which I took seriously. Thus, I would also like to have my attorneys review all paperwork at this time - they seem to be different from what was sent last time. Of course, this will be at my expense. I will call them ASAP to set up time to review.

Please feel free to contact me if you have any questions or concerns.

Regards,

Darius

2. E-mail dated July 27, 2003 from Jon Roberts to Inventor Mostowfi and e-mail dated July 28, 2003 from Inventor Mostowfi in response:

----- Original Message -----

From: "Jon Roberts" <Jroberts@Globe-IP.com>

To: "Darius Mostowfi" <darius@dsp.com>

Sent: Sunday, July 27, 2003 2:27 PM

Subject: RE: Patent Review - follow up on our phone call

> Hi Darius:
>
> Have you completed your review of the material we have sent? Please
advise since I have not yet heard on your progress.
>
> Thanks
> Jon
>

-----Original Message-----

From: Darius Mostowfi [mailto:darius@dsp.com]
Sent: Monday, July 28, 2003 11:40 AM
To: Jon Roberts
Cc: Darius Mostowfi
Subject: Re: Patent Review - follow up on our phone call

Jon - per your past email and phone message, you know it is unethical to be
contacting me directly since I am represented by an attorney.

My attorney is on vacation and will contact your firm when he returns.

I ask you NOT to contact me directly anymore via phone, email, mail, fedex,
etc. regarding this and ANY other matter.

Darius

3. E-mail dated August 29, 2003, from John Cooney summarizing a conversation with
Inventor Mostowfi:

-----Original Message-----

From: John M. Cooney [mailto:jcooney@i2telecom.com]
Sent: Friday, August 29, 2003 4:40 PM
To: Jon Roberts
Cc: Tony Zalenski (E-mail); Elliott Light; Doug Bender
Subject: RE: Mtg with Attorney

This morning (Friday, August 29, 2003) a little after 8:00am I received a cell
phone call from Darius requesting the FAX phone number for the i2 Telecom
Redwood City office. He needed this information to supply to the California
EDD as part of a claim he had filed.

In the course of the phone discussion, I stated that I had been given the
assignment of determining the likelihood of being able to bring the patent we
had been working on to closure. I then said that it might not be possible to
complete the patent work given the pending legal actions. Darius replied, no he
did not think it was likely.

Respectfully,

John M. Cooney
Director of Engineering
i2 Telecom International, Inc.
MG-2: 777-000-0101
Office: 650-474-8444
Cell: 650-722-1404
Email: jcooney@i2telecom.com

Web: i2Telecom.com

4. E-mails dated March 22, 2004 relating attempts to communicate with Inventor Mostowfi through his counsel.

-----Original Message-----

From: Byron Hollins [<mailto:Byron@HollinsLevy.com>]
Sent: Monday, March 22, 2004 4:22 PM
To: Naren Chaganti; Jon Roberts
Subject: RE: Cooperation of Mr. Mostowfi in Completing a POA

Mr. Chaganti: I authorize my client to communicate directly to you, with a copy to me, on this matter. Please make sure that your responses also contain a cc to me as well. Thank you for your cooperation.

Byron

-----Original Message-----

From: Naren Chaganti [<mailto:naren@chaganti.com>]
Sent: Monday, March 22, 2004 2:46 PM
To: Jon Roberts
Cc: Naren Chaganti; Byron Hollins
Subject: Re: Cooperation of Mr. Mostowfi in Completing a POA

Sir,

In view that you are represented by counsel, I think it is inappropriate that I communicate with you directly.

Kindly communicate with me via counsel.

Thank you very much,

Naren Chaganti, Esquire
432 S. Curson Ave, Ste. 12 H
Los Angeles, CA 90036
(650) 248-7011 phone (mobile)
(323) 571-9428 fax
naren@chaganti.com E-mail

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----- Original Message -----

From: Jon Roberts

To: Naren Chaganti (E-mail)

Sent: Monday, March 22, 2004 12:31 PM

Subject: Cooperation of Mr. Mostowfi in Completing a POA

Good afternoon Naren:

I am writing today to ask the cooperation of Mr. Mostowfi in completing a filing of a patent application that he reviewed in June of 2003. He was paid by I2 to review the application entitled "**System and Method for Using Multiple Communication Protocols in Memory Limited Processors.**"

Of course there is a law suit pending on various matters, the merits of which are yet to be decided, yet Mr. Mostowfi still has the action, for which he was paid, to review the application and execute a power of attorney with respect to that application.

My purpose in this email is to solicit the cooperation of your client in that action.

As his counsel, please let me know if you will accept that power of attorney for Mr. Mostowfi and have him execute the same.

Thank you in advance for your consideration.

Sincerely,
Jon L. Roberts

**ATTACHMENT 2
EVIDENCE RELATING TO INVENTOR MILOTA**

1. E-mail dated July 11, 2003 from Jon Roberts to Inventor Milota noting transmission of application documents.

----- Original Message -----

From: "Jon Roberts" <Jroberts@Globe-IP.com>
To: "Andre Milota (E-mail)" <milota@wans.net>
Cc: "Jack Robinson (E-mail 2)" <jrobinson@i2telecom.com>
Sent: Friday, July 11, 2003 10:12 AM
Subject: Patent reviews

Hi Andre:

Glad to meet you having heard your name for a number of months now.

Attached are tow documents

1. The January filing for your review (To be kept confidential and proprietary/not disclosed to anyone outside of I2)
2. A declaration and Power of Attorney (one document) for you to sign after your review of the patent application.

You also have the latest July patent application in review now. I have asked Tony to send you \$625 for the review of these applications.

Assignments for both of these applications will follow. The declaration/POA's DO NOT have to be notarized, the assignments DO have to be notarized.

Please call me with any questions.

Best regards,

Jon

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IMMEDIATELY BY TELEPHONE AND DELETE THE MESSAGE.

<<Declaration-POA (v.3).doc>> <<spec'n (2622-004)(TPE-VMS) as
filed.doc>>
<<Fig.1-8.pdf>>

2. Copy of FedEx AirBill 841277339842) evidencing transmission of application documents to Inventor Milota on May 6, 2004.

**ATTACHMENT 3
EVIDENCE RELATING TO INVENTOR PAPP**

1. E-mail dated October 3, 2003 from Inventor Cooney to Jon Roberts noting conversation with Inventor Papp

----- Original Message -----

From: John M. Cooney

To: Jon Roberts ; Doug Bender ; Tony Zalenski

Sent: Friday, October 03, 2003 9:26 AM

Subject: i2 Patent - Feed back from Al Papp

Last night (Thursday, October 2, 2003) Al Papp called me at home on my cell phone in response to the e-mail I had sent on September 19, 2003 regarding work on the i2 Telecom patent. The conversation was very pleasant, but the bottom line is that Al said he "is not available". Latter in the conversation Al asserted that the patent would need to move forward without his name or some that i2 would need to find some other mechanism for processing the patent.

I am wondering if we would not be better served by focusing on the other patent opportunities:

- * Fabrizio's switch for enabling the MG-2 repeater operation
- * Al's techniques for adapting to low bandwidth contexts

Respectfully,

John M. Cooney
Director of Engineering
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MG-2: 777-000-0101
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Cell: 650-722-1404
Email: jcooney@i2telecom.com
Web: i2Telecom.com